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Daniel P Burke Galano & Burke LLP 300 Rabro Drive Suite 135 Hauppauge, NY 11788			EXAMINER CHEN, TE Y	
			ART UNIT 2161	PAPER NUMBER
			MAIL DATE 08/29/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/057,016	Applicant(s) TURNASELLA, THEODORE	
	Examiner Susan Y. Chen	Art Unit 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 19, 2007 has been entered.

Claims 1-30 are pending for examination, claims 1, 12, and 20 have been amended, and claim 31 has been canceled.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11 and 20-30, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 1 and 20, it is unclear what does the claimed "at least one annual growth rate selected" (i.e., Does it refer to the selected annual growth rate of salary? Or

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inflation? Or others?) Furthermore, the only place of the instant specification that specifies the aging of salary is at the section [0035], which merely referred to the parameters in a control information table as: "The default gross percent parameter specifies the default value used in calculating aged wages for reports" or "The wage expire days parameter discloses the maximum number of days allowed for wage data before it is considered to expire", wherein, there parameters are not related to the claimed "at least one annual growth rate selected" as from Fig. 2. Therefore, based on the discussion above, these claims are deemed to be unclear.

As to claims 2-11 and 21-30, these claims have the same defects of their base claims, hence are rejected for the same reason.

Because the ambiguous nature of instant invention, the following art rejections are to the best as the examiner ascertain.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,741,993 issued to Zitaner et al. (hereinafter referred as '993) in view

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of U.S. Patent No. 6,401,079 issued to Kahn et al. (hereinafter referred as '079) and further in view of U.S. Patent No. 6,249,770 issued to Erwin et al. (hereinafter referred as '770).

As to claims 1, 12 and 20, the '993 patent discloses a system for providing survey data from members of a survey group via an Internet [e.g., Abstract, Fig. (s) 1-4], comprising:

a) a database for storing salary data [e.g., the unit 10, Fig. 1];

b) a server [e.g., the Reward Workbench (60), Fig. 1] providing access to the Internet, wherein the server configured to:

establishing a salary survey service [e.g., col. 5, lines 12-18, Fig. 2 and associated texts] and accepting salary data to the salary survey service [e.g., the 1st step of Fig. 3 wherein the row data elements including participant's and salary data at shown in Fig. 4] ;

receiving designations from the participants indicating the particular participants to be includes in a survey group, wherein the designation includes geographical information [e.g., col. 6, lines 23-65];

storing the salary data received from the at least a portion of the participants in the database [e. g., the 4th step of Fig. 3];

grouping the plurality of participants into survey group by the portion of the plurality of participants [e.g., the 2nd step of Fig. 3];

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generating a salary report for participants of the survey group using the stored data provided by the participants of the survey group [e.g., col. 6, lines 23-33]

providing access to the salary survey via the internet [e.g., Abstract, lines 8-10, the Data Network, Fig. 2].

The '993 patent did not specifically disclose aging salary data selected for at least a portion of stored salary data;

However, the '079 patent disclosed the claimed features "aging salary data selected for at least a portion of stored salary data" [e.g., the effective date, expiration date attributes of the Pay Scales table 435, the Pay Rate Types (430), etc. Fig(s). 4(b), 10(c) and associated texts].

The '993 and '079 patents are both in the same endeavor for efficiently reporting survey salary information via graphical interactive user interface [e.g., the Web unit 50, Fig. 2 of '993, the Fig(s). 18a - 18c of '079], thus, with the teachings of '993 and '079 in front of him/her, it would have been obvious for an ordinary skilled person in the art at the time the invention was made to be motivated to modify the salary information of '993 system with aging attributes as taught by '079 patent, because by doing so, the combined system will be upgraded to provide more details information for the pay scale survey and calculation.

The combination of '993 and '079 did not specifically disclose utilizing at least one annual growth rate entered at the time of generating said report.

However, '770 patent disclosed the step to utilize at least one annual growth rate entered at the time of generating said report [e.g., col. 11, line 48 – col. 12, line 20, Fig. 23].

The combination of '993, '079 and '770 patents are in the same endeavor for efficiently reporting survey salary information [e.g., the Web unit 50, Fig. 2 of '993, the Fig(s). 18a - 18c of '079, Fig. 23 of '770], hence, with the teachings of '993, '079 and '770 in front of him/her, it would have been obvious for an ordinary skilled person in the art at the time the invention was made to be motivated to modify the salary reporting information of the combined '993 and '079 system with the annual growth rate data as taught by '079 patent, because by doing so, the combined system will be upgraded to utilizing at least one annual growth rate entered at the time of generating to forecast a more accurate aged pay scale survey report with the annual growth rate details.

As to claims 2, 13 and 21, except all the features recited in claim s 1, 12 and 20, the combined system of '993, '079 and '770 patents further discloses that the survey are group by at least one of the business organization or others [e.g., '993: col. 1, lines 14-22].

As to claims 3-6, 14-16 and 22-25, except all the features recited in claims 1, 12 and 20, the combined system of '993 '079 and '770 patents further discloses that the members including individuals, companies, trade associations, contributor and subscriber [e.g., '993: col. 1, lines 26-35].

As to claims 7-8 and 26-27, except all the features recited in claims 1, 12 and 20, the combined system of '993 '079 and '770 patents further discloses that the server is further configured to receive designations of the members to be included in the survey group and parameters to defining information to be presented by the survey [e.g., '993: the first three steps of Fig. 3; Figure 4 and associated texts].

As to claims 9-10, 17-18 and 28-29, except all the features recited in claims 1, 12 and 20, the combined system of '993 '079 and '770 patents further discloses that the server is configured to provide access to the plurality members of the survey group [e.g., '993: the units 30, 32, 34, 36, Fig. 1].

As to claims 11, 19 and 30, except all the features recited in claims 1, 12 and 20, the combined system of '993 '079 and '770 patents further discloses that the salary data is related to job positions [e.g., '993: the Job_code, Position fields, Fig. 4].

Response to Arguments

Applicant's arguments filed on July 19, 2007 have been fully considered but they are not persuasive.

In summary, applicant's mainly argued that the combination of '993, '079 and '770 references do not specifically disclosed "aging at lest a portion of said salary data utilizing at least one annual growth rate selected at the time of generating said report for at least a portion of said stored salary data."

In reply to the above arguments, the examiner first points out that the claimed subject matters are under 35 U.S.C. 112, second paragraph rejections as recited above. Thus, USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997).

In addition, the examiner directs applicant's attention to the following excerpts from prior art:

For example, '993 disclosed a competitive rewards benchmarking system and method [e.g., Title, Abstract, Fig(s). 1-4 and associated texts] which comprising the following descriptions:

"Rewards workbench 60 provides members with a comprehensive analytic tool operable to access data contained in the competitive rewards database subsystem. The rewards workbench is preferably operable to: query prevalence of reward practices and plan provisions, compare member reward values to specific comparator groups, develop market reference data from the competitive

rewards database, model and develop base pay structure, analyze cost implications, conduct data mining analyses on member's own data, and generate other custom real-time analyses on the competitive rewards database. The generation of various reports and analysis based on competitive rewards database information is well within the scope of those skilled in the art."

"In a preferred embodiment, the rewards workbench provides for the formatting and export of formatted member data for submission to surveys. This information can be automatically transmitted to a third party HRMS. See FIG. 1, reference number 80."

"Rewards workbench 60, advantageously provides direct access to a robust data source to conduct a wide range of sophisticated analyses. This improves efficiency of survey submission process by leveraging initial benchmark matching and validation efforts (using the data capture tool). Rewards workbench 60 also allows electronic feed of competitive rewards data to other specialized human resources systems." (col. 6, lines 23 –49)

As set forth above, '993 disclosed all the claimed subject matter, except it did not specifically disclose aging salary data selected for at least a portion of stored salary data;

However, the '079 patent disclosed the claimed features "aging salary data selected for at least a portion of stored salary data" [e.g., the effective date, expiration date attributes of the Pay Scales table 435, the Pay Rate Types (430), etc. Fig(s). 4(b), 10(c) and associated texts].

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Moreover, the '777 invention specifically disclosed the step to utilize at least one annual growth rate entered at the time of generating said report [e.g., col. 11, line 48 – col. 12, line 20, Fig. 23].

Since the '993, '079 and '777 are in the same endeavor for efficiently reporting survey salary information [e.g., the Web unit 50, Fig. 2 of '993, the Fig(s). 18a - 18c of '079, Fig. 23 of '770], hence, with the teachings of '993, '079 and '770 in front of him/her, in contrary to applicant's arguments, it would have been obvious for an ordinary skilled person in the art at the time the invention was made to be motivated to modify the salary reporting information of the combined '993 and '079 system with the annual growth rate data as taught by '079 patent, because by doing so, the combined system will be upgraded to utilizing at least one annual growth rate entered at the time of generating to forecast a more accurate aged pay scale survey report with the annual growth rate details and the combination of these inventions are deemed to be a successful one.

Because applicant does not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections. The examiner concludes that the prior art on record read on the claimed features.

Conclusion

To expedite the process of re-examination, the examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. 35 U.S.C. 112) set forth by the Examiner prior to the office action, that applicant should provide and link to the most specific page and line numbers of the disclosure where best support is found (see 35 U.S.C. 132).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Y. Chen whose telephone number is 571-272-4016. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mofiz APu can be reached on 571-272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Susan Y Chen
Examiner
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A handwritten signature in cursive script that reads "Susan Chen".

August 24, 2007